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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,601	03/17/2004	Jon S. Gardner	(49146) 58738	7376
21874 7590 12/13/2007 EDWARDS ANGELL PALMER & DODGE LLP P.O. BOX 55874 BOSTON, MA 02205			EXAMINER JEAN, FRANTZ B	
			ART UNIT 2154	PAPER NUMBER
			MAIL DATE 12/13/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,601

Applicant(s)

GARDNER, JON S.

Examiner

Frantz B. Jean

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/21/04, 2/8/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This is a first office action in response to an application for patent filed on 03/17/04.

Claims 1-21 are presented for examination.

Information Disclosure Statement

The information disclosure statement (IDS) submitted on 02/08/05 and 6/21/04 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim1-15 and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Claim 1 recites the limitation "said postal server software". There is insufficient antecedent basis for this limitation in the claim.

Claim 12 recites said at premium service. There is insufficient antecedent basis for this limitation in the claim.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-21 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-42 of copending Application No.11/353,763. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are arguably broader than the claims of US patent application "763", which encompass the same metes, bounds, and limitations. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to eliminate the limitations of the narrower claims, since it has been held that omission of an element and its function and a combination where the remaining elements perform the same functions as before involves only routine skill in the art. See *in re Karlson*, 136 USPQ 184.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Powers
US patent Number 6,446,115.

As per claim 1, Powers teaches a communication system that transmits electronic mail among multiple sender and recipient terminals and which both uses and augments the Internet (see abstract), comprising: a postal server and software (see fig 1), links connecting the sender and recipient terminals and said postal server and software to the Internet, and sender software operable on at least the sender terminal that selectively connects the sender terminal to the postal server via the internet and said sender link, said postal server software providing premium mail services, and said sender terminal and software providing a selection of said premium services to be performed with respect to the transmitted electronic mail (see col. 15 line 63 to col. 16 line 62).

As per claim 2, Powers teaches a communications system according to claim 1 further

comprising recipient software operable at least on said recipient terminal that processes said mail received from said postal server and software via the internet and said recipient link (col. 15 line 63 to col. 16 line 10).

As per claim 3, Powers teaches a communication system according to claim 2 wherein at least one of said sender and recipient software is application software stored at said sender and recipient terminals (fig 1-3; col. 15 lines 63 to col. 16 line 30).

As per claim 4, Powers teaches a communication system according to claim 3 wherein the Internet has email application software and operates on the multiple sender and receiver terminals, said sender and receiver software is operable within said email application software (see abstract).

As per claim 5, Powers teaches a communication system according to claim 2 wherein at least one of said sender and recipient software is stored and accessible to the sender and/or recipient at said postal server (col. 17 lines 16-56).

As per claim 6, Powers teaches a communication system according to claim 2 wherein said links comprise a network interconnecting said multiple said terminals to the Internet, at least one of said sender, recipient and postal software is stored and/or accessible to the sender and/or recipient at said network (fig 1, col. 16 lines 31 et seq).

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As per claim 7, Powers teaches a communication system according to claim 1 further comprising payment software operable by at least said sender terminal and software and said postal server and software to authorize and account for payment for use of said postal server and software (col. 15 lines 10-61).

As per claim 8, Powers teaches a communication system according to claim 7 wherein said payment software accounts for incentive credits for a recipient terminal in response to opening of selected electronic mail at said recipient terminal (col. 15 lines 10-61).

As per claim 9, Powers teaches a communication system according to claim 7 wherein said payment software collects an additional fee in response to the sender software selection of optional services of said postal server and software (col. 15 lines 10-61).

As per claim 10, Powers teaches a communication system according to claim 1 wherein said connecting links between the internet and any of said sender terminal, recipient terminal, and postal server includes a telecommunications link (see fig 1, col. 16 lines 31-64).

As per claim 11, Powers teaches a communication system according to claim 1 wherein said connecting links between the internet and any of said sender terminal, recipient terminal, and postal server includes a link selected from the group consisting of: ISP, intranet, extranet, LAN, dial up, DSL, cable, satellite, cell, wireless, physical delivery and

combinations thereof (col. 16 lines 31-64)

As per claim 12, Powers teaches a communication system according to claim 1 wherein said at premium service is selected from the group consisting of: identification of said sender; certification of the identity of the entity operating said sender terminal; prioritization of sent and received mail; screening of mail for technical risks; screening of mail for content risks; encryption of mail; notification to sender of receipt of mail; notification to sender of opening of mail; pre-paid replies for recipient to respond to sender through the postal server; hard copy delivery of mail; customized incentives for recipients to open mail; verifiable date and time stamp of postal server processing; customized verification of decrypted content; creation of a holding of mail at said postal server; and payment and accounting for mail services; and combinations thereof (fig 3C; col. 17 lines 17 et seq).

As per claim 13, Powers teaches a communication system according to claim 12 where said prioritization is a differentiation between mail processed by said postal server and software and other electronic mail carried in the Internet (fig 2, address book table).

As per claim 14, Powers teaches a communication system according to claim 12 wherein said prioritization comprises a differentiation among mail processed by said postal server and software (fig 2; col. 8 lines 3-14; col. 9 lines 53-63).

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As per claim 15, Powers teaches a communications system according to claim 1 wherein said sender and recipient terminals and the Internet can have different combinations of operating systems and Internet software, and wherein the senders and recipients software are adapted to interface across said different combinations through the postal server (fig 2; col. 8 lines 3-14; col. 9 lines 53-63).

Claims 16-21 are a method of system claims 1-16. They are rejected under the same rationale.

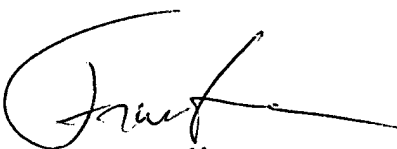
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantz B. Jean whose telephone number is 571-272-3937. The examiner can normally be reached on 8:30-6:00 M-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571-272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Frantz Jean



FRANTZ B. JEAN
PRIMARY EXAMINER